



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
05/137,097	05/03/93	FRANK	9 NYZ-041

RALE AND DOOR
60 STATE STREET
BOSTON MA 02109

18N2/0722

EXAMINER
LARSON, T

ART UNIT	PAPER NUMBER
1809	

DATE MAILED 07/22/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
08/467,397Applicant(s)
FRANK et al.Examiner
Thomas G. Larson, Ph.D.Group Art Unit
1809

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires SIX months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on 2 Jun 1997 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on 2 Jun 1997 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
 - ☒ will not be entered because:
 - ☒ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Please see attachment.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
The amendment to claim 1 raises new issues.
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: _____
- Claims objected to: _____
- Claims rejected: 1-51 and 207

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Other IDS submitted 2/19/97/ after final rejection mailed on 11/29/97 has been considered
considered. See attachment.

GEORGE C. ELLIOTT
SUPERVISORY PATENT EXAMINER
GROUP 1800

Art Unit: 1809

Attachment to Advisory Action

1. This application has been assigned to a new examiner.
2. The amendment to claim 1 deletes the limitation to specific SEQ. ID. NOS, thereby raising new issues that would require further search and/or consideration. A sequence is not provided for the complete epsilon region of the HBV genome in the sequence listing, therefore the limitation to a sequence complementary to the epsilon region of the HBV genome raises potential problems under 35 U.S.C. 112, 1st paragraph, with regard to the description requirement. New claim 225 is drawn to an oligonucleotide with sequences set forth in SEQ. ID. NOS: 7-19 and 45, and, therefore, go beyond the scope of allowable subject matter indicated by the previous examiner (interview of 12/19/96) of oligonucleotides directed to specific portions of the epsilon region of HBV (sequences set forth in SEQ. ID. NOS: 9-14 and 45) since portions of some oligonucleotide sequences are outside the epsilon region.
3. The information disclosure statement filed 2/3/97 after the final rejection mailed 11/29/96 has been considered in full based on the petition and certification filed 6/27/97 (paper 19).
4. Certain papers related to this application may be submitted to Art Unit 1809 by facsimile transmission. The FAX number is (703) 308-0294. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94

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(December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

5. Any inquiry concerning this communication or earlier communications should be directed to Dr. Thomas Larson, whose telephone number is (703) 308-7309. The examiner normally can be reached Monday through Friday from 9:00 AM to 5:30 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist, whose telephone number is (703) 308-0196.

Thomas G. Larson, Ph.D.
Examiner